

In re application of: Robert Keane, et al
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Examiner: Daniel Lastra
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Commissioner for Patents
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APPEAL BRIEF

This Appeal Brief is provided in support of the Notice of Appeal and Pre-Brief
Conference Request filed November 20, 2007 following the Notice of Panel
Decision mailed January 9, 2008.

I. Real Party in Interest

The real party in interest is VistaPrint Technologies Limited, a wholly owned subsidiary of VistaPrint Limited.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Claims 1-8 are pending in the application and each of Claims 1-8 stand rejected.

No other claims are pending.

IV. Status of Amendment

No amendments have been filed subsequent to the final rejection.

V. Summary of the Claimed Subject Matter

The pending claims are directed to methods for providing a product design software tool which allows a user to create an electronic product design, and which incorporates into the design an advertisement not provided by the user, and which offers the user the option of removing the advertisement. This method is particularly advantageous to an advertiser if the removal of the advertisement is performed upon payment of a fee by the user of the electronic product design software tool.

Independent Claim 1

Claim 1 recites a computer-implemented product design method comprising providing one or more product design software tools (16a in FIG. 1A, [0048], [0049]), the tools being adapted to (a) allow a user to create an electronic product design (FIGS. 3, 4A-4O, [0050], [0063]-[0069]) and (b) incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement (FIG. 4S, [0084], [0086]).

Dependent Claim 2

Claim 2 recites the method of claim 1 wherein the tools are further adapted to provide a product template to the user (FIGS. 4A-4O, [0063]-[0064]) and allow the user to incorporate user content into the template to create the electronic product design and wherein the advertisement is incorporated into the template (FIG. 4S, [0084], [0086]).

Dependent Claim 3

Claim 3 recites the method of claim 1 wherein the user must pay a fee to have the advertisement removed (FIG. 4S, [0084], [0086]).

Dependent Claim 4

Claim 4 recites the method of claim 1 wherein the tools are provided by a business to the user at no charge and wherein the advertisement is a promotional message for the business providing the tools (FIG. 4S, [0086]).

Independent Claim 8

Claim 8 recites a computer-implemented method for offering to produce products in physical form from an electronic product design prepared by a user (FIGS. 3, 4A-4O, [0050], [0063]-[0069]), the method comprising offering to produce the physical product at a first price if advertising not provided by the user is incorporated in the electronic product design such that the advertising will appear on the product when the product is produced (FIG. 4S, [0084], [0086]), and offering to produce the physical product at a second price if advertising not provided by the user is not included in the electronic product design (FIG. 4S, [0084], [0086]), the first price being lower than the second price (FIG. 4S, [0084], [0086]).

VI. Grounds of Rejection to be Reviewed on Appeal

A. Whether Claims 1-3, 5, 7 and 8 are unpatentable under 35 U.S.C. 102(e) as being anticipated by Ryan, Jr. et al. (US 6,173,274) (hereinafter “Ryan”).

B. Whether Claims 4 and 6 are unpatentable under 35 U.S.C. 103(a) over Ryan, Jr. et al. (US 6,173,274) (hereinafter “Ryan”).

VII. Argument

A. Claims 1-3, 5, 7 and 8 are NOT unpatentable under 35 U.S.C. 102(e) as being anticipated by Ryan Jr. et al. (US 6,173,274).

In the pending application, uses and benefits of the claimed invention are illustrated in the context of a print job management system 10 which processes a large number of orders for discrete print jobs (such as a business cards, letterheads, and envelopes for a business) from customers accessing the system over the Internet 14 via web browsers 13 running on individual customer's computers 11. (Specification [0048], [0049], FIGS. 1, 1A, 1B). Through the Internet 14, each customer can access a website 16 that includes a website studio 16a which provides design software that allows the customer to design his or her own print job, using the browser for design selection and editing. The website studio uses a user-friendly "what you see is what you get" ("WYSIWYG") functionality that allows the customer to choose a base design, or "template", for a desired printed item (e.g., business card or stationery), and then edit the design. (Specification, [0050], [0063], FIGS. 1A, 3, 4, and 4A-4W). The website studio allows the customer to choose a printed item from a wide selection of products (e.g., business cards, letterhead, invitations, brochures and marketing materials), view a variety of design templates that are available for the item and choose one, complete the template (e.g., by supplying new text, uploading graphics files and adjusting fonts), and save the resulting design. (Specification, [0064]-[0069], FIGS. 3, 4A-4O). Specific to the present invention, the web server host of the website studio automatically adds an advertisement (e.g., "Business Cards Printed for FREE at www.vistaprint.com") into the user design (see FIG. 4M), and charges a fee if the customer does not wish this advertisement to appear on the customer's products (see FIG. 4S). This feature is useful to printing service vendors that offer relatively low cost items, e.g., business cards, to customers by the web server host at no charge. The cost of printing these items can be recouped by the web server

host by requiring free items to incorporate an advertisement (for example, "Free Business Cards at www.vistaprint.com") into the user's final design of each free item, and charging a fee if the customer does not wish this advertisement to appear on the customer's printed items. (Specification [0084], [0086], FIG. 4S). Once the user's design is complete and the options such as opting to remove or not remove the incorporated advertisement from the user's design, the customer can then add the item to a shopping cart, and place an order. (Specification, [0064], FIG. 3).

Claims 1-7

Independent **Claim 1** is directed to a "computer-implemented product design method comprising providing one or more product design software tools, the tools being adapted to (a) allow a user to create an electronic product design and (b) incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement."

Turning first to the Ryan reference, Ryan discloses a production mail system 15 (e.g., a Pitney Bowes postage meter) for producing a mailpiece 301 including an inserter system 300 for feeding a document 17 in a path of travel and into an envelope 20. The document 17 includes a control code 82 printed thereon. The inserter 300 includes a scanner 314 which reads the control code 82 on the document 17 and a printer 372 which prints a selected message 60, as indicated in the control code 80, on the envelope 20. (Ryan, Abstract, and col. 4, lines 4-11) The control codes 82 are used to target recipients in particular industries with relevant advertisement messages 60. (Ryan, col. 13, lines 45-50).

Ryan further discloses a data processing system 80. The data processing system 80 is typically operated under the control of a user that produces high volume mailpieces for billing purposes (e.g., utility companies, credit card companies, insurance companies, etc.) or for statement purposes (e.g., banks, other financial companies, etc.). Generally, the user's host application software program collects and organizes various information relating to individual accounts that **customers**

maintain with the user. This information is utilized to produce customized documents corresponding to each customer's individual account. (Ryan, col. 5, lines 30-39).

As detailed in Ryan, col. 8, lines 15-37, Ryan's data processing system 80 includes a third party advertiser database 806, a recipient address and a control system in operative communication with the third party advertiser database 806. The third party advertiser database 806 includes a controller 802, a user profile 804, and an advertiser database 806. As detailed in Ryan, col. 8, line 59 – col. 9, line 41, a user data profile 804 is established for each of the individual user accounts and allows each user to set parameters for controlling third party advertising on their respective envelopes 20. This may be accomplished at the time when the user opens up an account with the data center 200 or at any other mutually convenient occasion. The user data profile 804 includes classification data 804a (such as whether the user is a commercial or residential user, the SIC code of the business that the user is engaged in), preference data 804b (such as preferred advertisers, whether the user wants automatic ad selection, and/or whether the user allows third party advertising at all), restriction data 804c (designating geographic regions, dates, particular recipient addresses, etc., where third party advertising is not allowed). As detailed in Ryan, col. 9, line 42 – col. 11, line 15, the ad data profile 807 stored in the advertiser database 806 includes graphic image data 807a (comprising the actual advertisement images), subsidy rate data 807b (comprising the amount to be credited to the user's invoice for printing of an associated message), billing rate data 807c (comprising the debit value that will be applied to the advertiser's account in conjunction with printing of the message), and restriction data 807d-807i (including geographic, data, multi-ad, ad space, and sender restrictions where a corresponding ad will not be printed).

Referring to Ryan, FIG. 6 and col. 11, line 28 – col. 12, line 48, in operation, a mailing list including a plurality of recipient address corresponding to a plurality of documents to be printed, inserted into corresponding printed envelopes, and

mailed, is received by the data processing system 80. Upon receipt of the mailing list, the data processing system 80 retrieves the user data profile file 804 associated with the user. If third party advertisement is allowed at all, the data processing system 80 searches the third party advertiser database 806 for messages available for printing on the envelope, reconciling the user preference data 804b, restriction data 804c, with the ad data profiles 807. Once the available messages are determined, the relevant messages and their corresponding subsidy rates 807b are presented to the user on the data processing system 80. This provides the user with the opportunity to view and analyze the available messages along with their corresponding subsidy rate 807b. Next, the user selects a message for printing on the envelope 20. Alternatively, if the user indicates in the preference data 804b to default to the highest paying message, then this activity may be automated. The data processing system 80 then generates a message indicator, a subsidy indicator, and a billing indicator all corresponding to the selected message 70 and incorporates the indicators into the control code 82 associated with the document 17 intended for printing. At printing time, when the inserter system 300 scans the control code 82 and uses the message indicator to print the selected message 70 on the envelope 20.

Turning now to the specific limitations of Applicant's Claim 1, Ryan first does not teach or suggest "providing one or more product design software tools, the tools being adapted to (a) allow a user to create an electronic product design". As described in detail above, the only software tool described in Ryan's system is the data processing system 80, which allows the user to set up the user data profile 804, including classification data 804a (i.e., commercial/residential user, SIC code of business, etc.), preference data 804b (e.g., preferred advertisers, automatic/manual ad selection, third party advertising enabled/disabled, etc.), and restriction data 804c (recipient address-based, date, etc.). The user submits a mailing list including a plurality of recipient addresses. The data processing system 80 then determines available advertisement messages that may be selected by the user (either manually, or automatically based on the user data profile 804) to

be printed on the envelope. If any messages are selected, a message indicator is incorporated into the control code 82, which is read by the inserter system scanner and interpreted to determine which, if any, messages are to be printed on the envelope. Importantly, however, the data processing system 80 does not create or generate an electronic product design. Rather, Ryan's data processing system 80 creates only a control code 82. There is no teaching or suggestion in Ryan that the data processing system 80 creates, either by itself or under the direction of the user, an actual electronic product design. To summarize, Ryan teaches only a software tool that processes recipient addresses to generate corresponding control codes 82 based on information from a user data profile 804 and third party advertiser profiles 807, wherein the control codes 82 may be interpreted by the inserter system in determining which, if any messages to print on the envelopes. Accordingly, the data processing system 80 cannot be equated with Applicant's recited "one or more product design software tools, the tools being adapted to (a) allow a **user** to create an **electronic product design**". Since Ryan discloses no other software tool having a user interface, Ryan clearly does not teach this limitation.

Ryan also does not teach or suggest "one or more product design software tools, the tools being adapted to ... (b) incorporate into the design an advertisement **not provided by the user**." As explained above, Ryan's data processing system 80 searches for available messages according to the user data profile 804 and the ad data profiles 807 from the third party advertiser database 806, and the **user** provides, through the act of selecting, a message for incorporation into the printed design, either through active selection from available messages presented to the user by the system 80, or by indicating to the system 80, via the user data profile 804, to select the message with the highest paying subsidy. In either case, in Ryan's system, it is the **user**, and not the data processing system 80 software tool itself or the third party advertisers, that selects the message to be printed, and therefore it is the **user** that provides a message for incorporation into the items to be printed on the envelope.

Thus, to clarify, Ryan's system requires a user to actively select, and therefore provide, a message to be incorporated into a final printed envelope. In contrast, the Applicant's claimed method incorporates an advertisement that was never requested by, selected by, or provided by, not supplied by the user, into the user's design, and then requires the user to actively opt not to incorporate it.

Ryan also does not teach or suggest "one or more product design software tools, the tools being adapted to ...(b) **incorporate into the design an advertisement** not provided by the user, **and offering the user the option of removing the advertisement.**" In Ryan, the user must actively select a message to incorporate into the printed envelope. In contradistinction to Ryan, in Applicant's claimed method, the user action is the active selection **not** of which message to select, but rather of **whether to opt in or out of a non-user-provided incorporated advertisement.**

Finally, Ryan's teachings actually teach away from the Applicant's recited method. Ryan's system requires a user to actively select a particular advertisement from a number of available subsidized advertisements for printing on the envelope in order to take advantage of a subsidy associated with the selected ad. Thus, Ryan must actually provide **incentive** to get the user to opt to print the ad. The **incentive** is in the form of a subsidy on the postage or meter invoice in exchange for printing the ad. In contrast, users of the Applicant's claimed method must actively opt (for example, by paying a surcharge) to remove a non-user advertisement from their user design, and thus, because there is the additional work to remove the ad (and because in some embodiments the user must pay a surcharge to remove the ad) there is a **dis-incentive** on the part of the user to remove the ad.

Thus, for all of the above reasons, the Applicant respectfully maintains that Ryan does not teach or suggest "one or more product design software tools, the tools

being adapted to ... (b) incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement.”

It will be noted that Ryan does disclose that the user data profile 804 may include an indicator 804b which allows the user of the postage meter to bypass third-party advertisement altogether. (Ryan, Col. 9, lines 13-16). However, if this indicator is set to bypass all advertisements altogether, the data processing system 80 does not search or present or select **any** third party advertisements for possible incorporation into the printed envelopes, and therefore would still not meet the limitation “incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement”.

A prima facie case for anticipation under 35 U.S.C. §102 requires that a reference teach each and every element of the claim. As described in detail above, Ryan clearly does not teach all of the limitations of Applicant’s independent Claim 1. In particular, Ryan does not teach or suggest a “computer-implemented product design method comprising providing one or more product design software tools, the tools being adapted to (a) allow a user to create an electronic product design and (b) incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement.” Accordingly, the Applicant respectfully contends that the Examiner has not built a prima facie case for obviousness under 35 U.S.C. §102, and that the rejection of Claim 1 under 35 U.S.C. §102(b) should therefore be withdrawn.

Each of **Claims 2-7** depends from independent base Claim 1 and adds further limitations. Claims 2-7 are believed allowable for at least the same reasons that independent Claim 1 is believed allowable over the cited references.

Claim 2

Claim 2 is believed allowable on independent grounds because Ryan does not teach or suggest “wherein the tools are further adapted to provide a product

template to the user and allow the user to incorporate user content into the template to create the electronic product design and wherein the advertisement is incorporated into the template". As described in the Applicant's Specification at least at paragraphs [0063]-[0064], [0084] and [0086] and shown in FIGS. 4A-4O and 4S, the website studio allows the customer to view a variety of design templates that are available for the item and choose one, complete the template (e.g., by supplying new text, uploading graphics files and adjusting fonts), and save the resulting design. The web server then automatically incorporates an advertisement into the user's saved design, and then offers to remove the advertisement for a fee.

Ryan's data processing system 80, however, does not provide a design tool that provides a product template to a user, or any functionality for incorporating user-provided content into the template, or further any functionality for automatically incorporating an advertisement into the template. As described above, the data processing system 80 only allows the user to provide a user data profile 804, which includes classification data 804a, preference data 804b, and restriction data 804c. However, the user data profile 804 is not a template. The data processing system 80 also may present the available messages to the user for selection if the selection is not automated by setting the "automate selection" flag in the preference data 804b of the user data profile 804. However, again, any message selected for printing either by user's manual selection or user's request for automatic selection are not automatically incorporated into the printed design but are specifically requested by the user to be incorporated into the printed design. Thus, Ryan does not meet the limitation "wherein the tools are further adapted to provide a product template to the user and allow the user to incorporate user content into the template to create the electronic product design and wherein the advertisement is incorporated into the template" as recited in Applicant's Claim 2. Accordingly, the Applicant respectfully contends that the rejection of Claim 2 under 35 U.S.C. §102(e) should be withdrawn.

Claim 3

Claim 3 is believed allowable on independent grounds because Ryan does not teach or suggest the limitation “wherein the user must pay a fee to have the advertisement removed.” As described in detail above, Ryan performs the opposite of this limitation – namely, in Ryan the user is paid (via a subsidy or invoice credit) to print the advertisement. Accordingly, the Applicant respectfully contends that the rejection of Claim 3 under 35 U.S.C. §102(e) should be withdrawn.

Claim 8

Independent **Claim 8** recites a “computer-implemented method for offering to produce products in physical form from an electronic product design prepared by a user, the method comprising offering to produce the physical product at a first price if advertising not provided by the user is incorporated in the electronic product design such that the advertising will appear on the product when the product is produced, and offering to produce the physical product at a second price if advertising not provided by the user is not included in the electronic product design, the first price being lower than the second price. As discussed above with respect to Claim 1, Ryan does not teach or suggest “an electronic product design prepared by a user”. To the extent that there even is an electronic design of the envelope, that design is created by the inserter system/printer, not the user. The user’s action of reviewing a group of available advertisements and choosing one to be printed on an envelope otherwise designed entirely by the printer does not make the envelope fall within any reasonable definition of “an electronic product design prepared by a user”. Furthermore, Claim 8 requires that the advertising that is incorporating into the electronic product design is not provided by the user. The Ryan user, by contrast, clearly provides the advertisement because an advertisement is incorporated only after it has been reviewed, selected, and authorized by the Ryan user. Accordingly, the Applicant respectfully contends that the rejection of Claim 8 under 35 U.S.C. §102(b) should be withdrawn.

B. Claims 4 and 6 are NOT unpatentable under 35 U.S.C. 103(a) over Ryan, Jr. et al. (US 6,173,274).

A prima facie case for obviousness under 35 U.S.C. §103 requires that the references, taken in combination, teach all of the elements of the claim. As described in detail above, Ryan does not teach all of the limitations of Applicant's independent Claim 1, including a "computer-implemented product design method comprising providing one or more product design software tools, the tools being adapted to (a) allow a user to create an electronic product design and (b) incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement." Since each of **Claims 2 and 6** depend from Claim 1 and add further limitation, the Applicant respectfully contends that the Examiner cannot build a prima facie case rejecting Claims 2 and 6 for obviousness under 35 U.S.C. §103 because Ryan does not even teach all of the limitations of the independent base claim from which they depend.

Claim 4

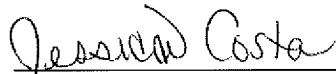
In addition, **Claim 4** is believed allowable on independent grounds because Ryan does not teach or suggest the limitation "wherein the tools are provided by a business to the user at no charge and wherein the advertisement is a promotional message for the business providing the tools." Dependent claim 4 recites that the product design software tools are provided by a business and that the advertisement is a promotional advertisement for the business providing the tools. Ryan repeatedly recites that the advertising is advertising for "third party advertisers". There is no mention in Ryan of any advertisement being for the company that is providing the advertisement selection system described at col. 12, lines 23-29 in connection with printing the user's envelope. Accordingly, the Applicant respectfully contends that the rejection of Claim 4 under 35 U.S.C. §103(a) should be withdrawn.

Conclusion

For the reasons set forth above, Applicant respectfully submits that each of Claims 1-8 is patentable and reversal of all rejections is respectfully requested.

Respectfully submitted,

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VIII. Claims Appendix

1. A computer-implemented product design method comprising
providing one or more product design software tools, the tools being
adapted to
 - (a) allow a user to create an electronic product design and
 - (b) incorporate into the design an advertisement not provided by the user, and
offering the user the option of removing the advertisement.
2. The method of claim 1 wherein the tools are further adapted to provide a
product template to the user and allow the user to incorporate user content into the
template to create the electronic product design and wherein the advertisement is
incorporated into the template.
3. The method of claim 1 wherein the user must pay a fee to have the
advertisement removed.
4. The method of claim 1 wherein the tools are provided by a business to the
user at no charge and wherein the advertisement is a promotional message for the
business providing the tools.
5. The method of claim 1 wherein the electronic product design is the design
of a product that the user desires to be produced in physical form and wherein the
method further comprises

offering to produce the physical product for the user at a first price if the advertisement appears on the produced product, and

offering to produce the physical product for the user at a second price if the advertisement does not appear on the produced product, the second price being greater than the first price.

6. The method of claim 5 wherein the first price is free.

7. The method of claim 5 wherein the electronic product design is the design of a product intended to be printed and the physical product is a quantity of printed copies of the printed product.

8. A computer-implemented method for offering to produce products in physical form from an electronic product design prepared by a user, the method comprising

offering to produce the physical product at a first price if advertising not provided by the user is incorporated in the electronic product design such that the advertising will appear on the product when the product is produced, and offering to produce the physical product at a second price if advertising not provided by the user is not included in the electronic product design, the first price being lower than the second price.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None